

REMARKS

Claims 1-36 are pending in the Application. The specification and claims are objected to. Claims 1-36 are rejected under 35 U.S.C. §112, second paragraph. Applicant respectfully traverses these rejections for at least the reasons stated below and respectfully requests that the Examiner reconsider and withdraw these rejections.

Applicant notes that claims 1, 2, 28, 29 and 31 have been amended to correct typographical mistakes and not to overcome prior art. Furthermore, Applicant has amended claim 28 to overcome an insufficient antecedent basis rejection and not to overcome prior art. Hence, no prosecution history estoppel arises from the amendments to claims 1, 2, 28, 29 and 31. *Festo Corp v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-1712 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 1, 2, 28, 29 and 31 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

I. OBJECTIONS TO THE SPECIFICATION:

The Examiner has objected to the Specification because of using an improper term on page 3, line 10 and for missing a parenthesis on page 7, lines 3-4. Paper No. 3, page 2. As indicated above, Applicant has amended the Specification by replacing the term "V1M2 mode" with "10M8 mode" on page 3, line 10 of the Specification as well as amended the Specification by inserting a parenthesis after the phrase "*not* ConfigV2" on page 7, line 4 of the Specification. Applicant respectfully requests the Examiner to withdraw the objections to the Specification.

II. OBJECTIONS TO THE CLAIMS:

The Examiner has objected to claims 1, 2 and 28. Paper No. 3, page 2. In particular, the Examiner has objected to claim 1 for first using the term "PCOM" on

line 3 without previously defining "PCOM." Paper No. 3, page 2. As indicated above, Applicant has amended claim 1 by replacing the first use of the term "PCOM" on line 3 of claim 1 with the phrase "Private Communication Field (PCOM)" as well as replacing the phrase "private communication field (PCOM)" on line 4 of claim 1 with the phrase "PCOM".

The Examiner has further objected to claim 2 for using the term "asserted" instead of using the term "asserting". Paper No. 3, page 3. As indicated above, Applicant has amended claim 2 by replacing the phrase "asserted" with the phrase "asserting."

The Examiner has further objected to claim 28 for using the term "PCOM" on line 2 without previously defining "PCOM." As indicated above, Applicant has amended claim 28 by replacing the term "PCOM" on line 2 of claim 28 with the phrase "Private Communication Field (PCOM)".

Accordingly, Applicant respectfully requests the Examiner to withdraw the objections to the claims.

III. REJECTIONS UNDER 35 U.S.C. §112:

The Examiner has rejected claims 1-36 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Paper No. 3, page 3. In particular, the Examiner states:

Claims 1 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP §2172.01. The omitted elements are: the limitation "a force-second-mode signal" in line 13 of the claim 1 and in line 19 of the claim 28 is not adequately disclosed by the drawings and specification. Accordingly, in Figures 3 and 4, there is only a disclosure of the limitation "a force-first-mode signal"; however, the "a force-second-mode signal" has not been clearly disclosed in both drawings and specification. Paper No. 3, page 3.

Applicant respectfully traverses and asserts that claims 1 and 28 do not omit matter disclosed to be essential to the invention as described in the Specification. Accordingly, claims 1-36 are allowable under 35 U.S.C. §112, second paragraph.

Applicant respectfully asserts that the phrase "a force-second-mode signal" is not an essential element omitted from claims 1 and 28. In fact, the phrase has been inserted in these claims. For example, in claim 1 it recites "determining if a force-first-mode signal is asserted, or a combination of a force-second-mode signal not being asserted and either the detected signal or the signaled signal being asserted." Hence, the allegedly essential element has not been omitted from claims 1 and 28.

Furthermore, if the Examiner is asserting that the phrase "determining if a force-first mode is asserted, or a combination of a force-second-mode signal not being asserted and either the detected signal or the signaled signal being asserted" cannot be determined by one having ordinary skill in the art, Applicant respectfully traverses. Applicant kindly directs the Board's attention to page 8, lines 10-18 of the Specification, which describes, in part determining if the FORCE_V1P0 signal is asserted, or the CONFIG_V1 signal is asserted, or if there is a combination of the CONFIG_V2 signal not being asserted and the V1_DET_SIG signal being asserted. The cited passage in the Specification further describes that the FORCE_V1P0 signal is asserted when the 10M8 station is to be forced into the 1M8 mode with a PCOM=0. The cited passage in the Specification further describes that the CONFIG_V1 signal is asserted when the 10M8 station is to be forced into the 1M8 mode with a PCOM=1. The cited passage in the Specification further describes that the CONFIG_V2 signal is asserted when the 10M8 station is to be forced into the 10M8 mode. The cited passage of the Specification further describes that the V1_DET_SIG signal is asserted when either the V1_DETECTED signal or the V1_SIGNED signal is asserted. Hence, the Specification describes determining if the FORCE_V1P0 signal is asserted or if there is a combination of the CONFIG_V2 signal not being asserted and either the V1_DETECTED signal or the V1_SIGNED signal is asserted. It is noted that this interpretation is illustrative and that Applicant is not limited to this interpretation. A rejection under 35 U.S.C.

§112, second paragraph, is not appropriate, when the scope of the claimed subject matter can be determined by one having ordinary skill in the art. M.P.E.P. §706.03(d). One having ordinary skill in the art can determine the scope of the claimed subject matter, including the phrase "determining if a force-first mode is asserted, or a combination of a force-second-mode signal not being asserted and either the detected signal or the signaled signal being asserted." Consequently, Applicant respectfully asserts that claims 1-36 are allowable under 35 U.S.C. §112, second paragraph.

Furthermore, the Examiner states that the limitation of "the station" on line 3 of claim 28 does not have sufficient antecedent basis. Paper No. 3, page 4. Applicant has amended claim 28 to replace the phrase "the station" with "a station". Accordingly, Applicant respectfully asserts that claim 28 has sufficient antecedent basis. Consequently, claims 28-36 are allowable under 35 U.S.C. §112, second paragraph.

IV. CONCLUSION

As a result of the foregoing, it is asserted by Applicant that claims 1-36 in the Application are in condition for allowance, and Applicant respectfully requests an allowance of such claims. Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Applicant

By: 

Kelly K. Kordzik
Reg. No. 36,571
Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

Austin_1 263633v.1